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427-468

APPLICATION NUMBER	FLING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/427,468	04/24/95	FRIESE	A J&J-1500
		EXAMINER	
33M1/1015		REF. FILE NO.	PAPER NUMBER
AUDLEY A CIAMPORCERO JR JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK NJ 08933-7003			48
		3308	
		DATE MAILED:	10/15/97

This is a communication from the examiner in charge of your application.
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OFFICE ACTION SUMMARY

- Responsive to communication(s) filed on 4-14-97
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- Claim(s) 9-12, 14-19, 23-26 and 28 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 9-12, 14-19, 23-26 and 28 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The proposed drawing correction, filed on 4-14-97 is approved disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) _____
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- Notice of Reference Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

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The oath or declaration is objected to for the reasons set forth on page 2, lines 1-9 of a previous Office Action, Paper No. 28.

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on April 14, 1997 have been approved.

Applicant's remarks in the paragraph bridging pages 3-4 have been noted.

*AM 2
10/9/97* The amendment filed *August 22, 1994 and April 14, 1997* is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 3, lines 20-21, page 4, line 6, and page 4, line 27.

Applicant is required to cancel the new matter in the response to this Office action.

Applicant's remarks on page 3, lines 19-24 and page 4, lines 4-15, have been considered but are deemed nonpersuasive as Figures 2 and 4 nor page 7, lines 26-29 were not originally presented as alternatives. Nor do Figures 1 and 2 which show the tampon prior to expansion show no structure which restrains radial expansion, for example, there is no evidence that later expansion isn't restrained due to earlier expansion of the closer set portions of the ribs.

Claims 9-12, 14-19, 23-26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See new matter objection to the specification

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supra and MPEP 2163.06, i.e. claim limitations, e.g. the interpretation thereof in light of the specification, e.g. what is the "tampón" as referred to claims 9-12, 14-19 and the species encompassed by claims 23-26 and 28, are affected by added material. Also, the objection and rejection on page 3, line 25 - page 4, line 2 and page 4, lines 5-17 of Paper No. 28 and page 4, lines 15-27 with respect to claim 28^{of the last Office Action} are repeated here. The invention encompassed by the claims was not clearly conveyed to those skilled in the art at the time the application was filed.

Claims 9-12, 14-19, 23-26 and 28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The objection and rejection on page 3, lines 25-page 4, line 2 and page 4, lines 5-7 and 10-12 of Paper No. 28 is repeated.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: positive structural antecedent basis for claim 15 should be defined.

It is noted that the above objections and rejections are the same as those previously presented but rewritten with new form paragraphs.

Applicant remarks on page 3, lines 12-17, page 4, line 16 - page 7, line 2 have been noted.

The remarks are deemed non-persuasive for the reasons set forth supra. Examiner's comments on page 3, first and last full paragraphs are also repeated. In other words, the originally filed

specification fails to clearly convey or enable what the invention was, i.e. unclear whether the

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tampon and the apparatus used to produce such were and produced a tampon with open passages, or closed passages or that there was more than one embodiment. Subsequent prosecution has not lessened such confusion.

The remainder of Applicant's remarks have been noted.

Claims 9-12, 14-19, 23-26 and 28 distinguish over the art. See last Office Action.

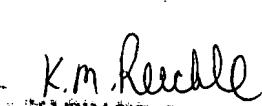
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Brinker reference, not of good date, is made of record.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.


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ART UNIT 3308